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Bruno Bret

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31743

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Georgia-Pacific LLC

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EXAMINER

AL-AWADI, DANAH J

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1615

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Response to Amendment

Receipt of Applicants arguments/remarks and declaration filed 06/17/2010 is acknowledged.

The Examiner acknowledges the following:

Claims 15 has been amended

Thus, claims 15-29 currently represent all claims under examination.

INFORMATION DISCLOSURE STATEMENT

No New Information Disclosure Statements has been submitted for review.

WITHDRAWN REJECTIONS

Rejections not reiterated from previous Office Actions are hereby withdrawn. The following rejections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

MAINTAINED REJECTIONS

The following rejection has been maintained from the previous office action dated (03/17/2010):

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

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matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 15-22, 24, and 26-29 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Bret et al. (US Patent 6146648).

Bret et al. U.S. Patent 6146648 (hereafter '648 patent) teaches a composition that comprises a waxy ester and a fatty alcohol on a fibrous material for use in contacting skin. The purpose of the composition is to make the fibrous material softer. Regarding the fatty acid ester of claim 15 in the instant application, Claim 4 of '648 patent states that the composition was derived from one or more fatty alcohols which have 6 to 24 carbon atoms. Claim 4 further states

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a waxy ester also derived from saturated linear fatty acids having from 6 to 24 carbon atoms.

With respect to the specific range of carbon atoms stated, chapter 2144.05 of MPEP states “In the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art” a prima facie case of obviousness exists. With respect to the range of the amount of product per surface area, chapter 2144.05 states “Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.”

With regards to the fibrous material imparting a sense of freshness of pending claim 15, this is treated as intended use and carries little patentable weight.

With regards to the melting temperature of claim 16 of the instant application, Claim 1 of ‘648 patent states that the composition melts at least 5°C, and therefore the composition also melts at a range from 20°C to 37°C.

Claim 17 of the instant application calls for a composition of at least 40% being selected from solvents, fatty acid esters, fatty alcohols, or mineral oils. Claim 8 (i) of ‘648 patent teaches that the composition comprises from 0 to 50% of wax or mineral oil.

Claims 18 and 19 of the instant application discuss dodecylic esters. Claim 4 of ‘648 patent teaches a waxy ester of 6 to 24 carbon atoms. With respect to the specific range of carbon atoms stated, chapter 2144.05 of MPEP states “In the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art” a prima facie case of obviousness exists.” A dodecylic ester is a 12 carbon ester. Furthermore, Paragraph 83 of the brief summary ‘648 patent teaches lauric acid which is dodecanoic acid. With respect to the percentage, claim 20 part (b) of ‘648 patent teaches a composition from 5 to 99% wt of an aqueous emollient compound of which

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is comprised of at least one waxy ester. Furthermore, claim 8 of '648 patent teaches a composition which comprises from 1 to 50% of waxy esters. Dodecylic acid is a waxy ester. With respect to the percentages in the instant claims 17 and 18, chapter 2144.05 of MPEP states that ““Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.”

Claim 20 of the instant application states the agent is distributed substantially on the surface of the product. Paragraph 1 of the brief summary of '648 patent states that “the lotion is applied or impregnated onto at least on surface...” Impregnated onto is understood to be applied substantial to the surface.

With respect to the range of the amount of product per surface area of claims 21 and 22 of the instant application, chapter 2144.05 of the MPEP states “Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.”

With regards to the distribution of the agent in strips parallel to each other in claim 24 of the instant application, Paragraph 131 of the brief description of '648 patent discloses a method of depositing lotion in the form of strips.

Claim 26 of the instant application states the agent is distributed over a top surface and a bottom surface of said product. Paragraph 25 of the detailed description of '648 patent states that an object of the invention is to provide a paper product which has at least one surface that is coated with an agent, of which is lotion. Therefore, distributing the agent over the top surface and bottom surface is at least one surface.

Claim 27 of the instant application states that the fibrous material comprises absorbent paper. Claim 20 of '648 patent teaches absorbent paper product. Absorbent paper is fibrous material.

Claims 28 and 29 of the instant application discuss that the fibrous material comprises absorbent cotton or a bonded web of natural, artificial, or synthetic textile fibers. Claim 20 of '648 patent teaches absorbent paper, and absorbent paper is made of up of natural, artificial, or synthetic textile fibers. Cotton or cotton in mixture with artificial or synthetic fibers is an obvious version of absorbent paper. The abstract of '648 patent teaches that the composition is used in treating absorbent paper products of which include according to Paragraph 2 of the brief summary, paper products paper products such as handkerchiefs, toilet paper, or any other paper products for wiping the skin. Furthermore, Paragraph 1 of the brief summary of '648 patent teaches that the paper product can include a sheet of wadding cotton or tissue paper. Paragraph 27 of the brief summary of '648 patent teaches an absorbent paper sheet made up of mostly paper fibers and of synthetic fibers or any other equivalent paper product.

Claims 23-26 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Bret et al. US Patent 6146648 as applied to claims 15-22, 24, and 26-29 above, and further in view of Wegele et al US Patent 6270878.

Claims 23 -26 of the instant application discuss distribution patterns of the agent. US patent 6270878 (hereafter '878 patent) discloses that it is advantageous to have a wipe that has a discontinuous distribution pattern. Paragraph 9 of the brief summary of '878 patent teaches that a continuous pattern of emulsion has been found to not provide the most efficacious cleaning of human skin. It is known in the art that distribution is normally done in a continuous fashion.

With regards to a discontinuous manner, the strips are parallel; it is therefore understood to also be distributed in a discontinuous manner. In regards to claim 26 of the instant application, distribution over a top surface and a bottom surface is also an obvious variant of discontinuous distribution.

The teachings of '648 patent doesn't disclose distribution patterns, however the '878 patent discloses known distribution patterns of emollient, and the claimed distribution patterns of the instant application are obvious variants and do not add patentable weight. It would have been prima facie obvious to combine the teachings of '878 patent with the teachings of '648 patent because '878 patent teaches a composition distribution having the advantage of more efficacious cleaning of human skin.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bret et al. US Patent 6146648 as applied to claims 15-22, 24, and 26-29 above, and further in view of Muoio US patent 3965518.

U.S. Patent 3965518 (hereafter '518 patent) discloses the advantage of the continuous application. Paragraph 6 and 7 the brief summary of '518 patent discloses an advantage of continuous distribution in that it provides an even application of product.

The teachings of '648 patent doesn't disclose distribution patterns, however the '518 patent discloses known distribution patterns of emollient, and the claimed distribution patterns of the instant application are obvious variants and do not add patentable weight. It would have been prima facie obvious to combine the teachings of '518 patent with the teachings of '648 patent because '518 patent teaches a composition distribution having the advantage of a more even application of product.

RESPONSE TO ARGUMENTS

Applicant's arguments with regards to the rejection of claims 15-22, 24, and 26-29 under 35 U.S.C. § 103(a) as being unpatentable over Bret et al. (US Patent 6146648) have been fully considered but they are not persuasive.

Applicant argues that one would be lead away from forming a fibrous material that imparts a sense of freshness where the product contains, in part, at least one fatty acid ester with a C10-C14 carbon chain and an alcohol with a C10-C14 carbon chain. Bret discloses that while linear fatty alcohols of 6 to 24 carbon atoms an linear fatty acids with 6 to 24 carbon atoms can be used to form the waxy esters, the combination must be such that the waxy esters have at least 24 carbon atoms.

In response the examiner respectfully submits that Brett teaches that the waxy esters are derived from saturated linear fatty acids with 6 to 24, preferable 10 to 24 carbon atoms, and more preferably 12 to 22 carbon atoms, and of saturated linear fatty alcohols with 6 to 24, preferably 10 to 24 carbon atoms, and more preferably 12 to 22 carbon atoms (paragraph of line 34 column 8). Brett goes on to state these waxy esters can be prepared from long-chain fatty acid with a fatty alcohol of a shorter chain or vice-versa. The chain lengths of the alcohol and the fatty acid can be identical provided that the ester has at least 24 carbon atoms. The examiner interprets this statement to mean that if the lengths are identical then the ester would have 24 carbon atoms when both lengths are identical, but not necessarily all other situations. Although in preferred embodiments the fatty acid constitutes at least 24 carbon atoms, disclosed examples and

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preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi 440 F.2d 442, 169 USPQ 423 (CCPA 1971). The very next paragraph of Bret goes on to state that examples of waxy esters are lauric and lauric ester has less than 24 carbons (line 46 column8).

CONCLUSION

All claims have been rejected; no claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

CORRESPONDENCE

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danah Al-awadi whose telephone number is (571) 270-7668. The examiner can normally be reached on 9:00 am - 6:00 pm; M-F (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

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supervisor, Robert A. Wax can be reached on (571) 272-0623. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DA/

Examiner, Art Unit 1615

/Robert A. Wax/
Supervisory Patent Examiner
Art Unit 1615